

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte BRUCE KING

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Appeal No. 2000-0082  
Application No. 08/745,472<sup>1</sup>

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ON BRIEF

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Before CALVERT, FRANKFORT and NASE, Administrative Patent Judges

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 3 and 5 to 21, all the claims remaining in the application.

The claims on appeal are drawn to a golf club adapted for use as a putter, and are reproduced as Exhibit A of

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<sup>1</sup> Application for patent filed November 12, 1996.

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appellant's brief.

The references applied in the final rejection are:

|            |           |               |
|------------|-----------|---------------|
| Solheim    | 3,042,405 | July 3, 1962  |
| Taylor     | 3,954,265 | May 4, 1976   |
| Finney     | 4,999,000 | Mar. 12, 1991 |
| Simmons    | 5,489,097 | Feb. 6, 1996  |
| Mendenhall | 5,518,235 | May 21, 1996  |
| Meyer      | 5,544,883 | Aug. 13, 1996 |

"Skyway T-Line Putters," Golf Digest, p.29 (December 1974)  
(hereinafter Skyway).

The appealed claims stand finally rejected under 35  
U.S.C.

§ 103(a) as unpatentable over the following combinations of  
references:

- (1) Claims 1 to 3, 5 to 8, 11, 13 and 14, Simmons in view of  
Mendenhall, Solheim and Finney;
- (2) Claims 9, 10, 15, 16, 18 and 21, Simmons in view of  
Mendenhall, Solheim, Finney and Taylor;
- (3) Claim 12, Simmons in view of Mendenhall, Solheim, Finney  
and Skyway;
- (4) Claim 17, Simmons in view of Mendenhall, Solheim, Finney,  
Taylor and Meyer;
- (5) Claims 19 and 20, Simmons in view of Mendenhall, Solheim,

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Finney, Taylor and Skyway.

After fully considering the record in light of the arguments presented in the brief and reply brief, and in the examiner's

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answer, we conclude that the claims on appeal are patentable over the prior art as applied in rejection (1) to (5), supra. Our reasons for this conclusion are discussed below.

Each of independent claims 1, 15 and 21 contains a similar limitation concerning the relative masses of the proximal heel portion and distal toe portion of the club head: Claims 1 and 21 recite that the distal toe portion has "a mass which is less than the mass of the [said] proximal heel portion," while claim 15 recites proximal and distal bulkheads, with "said proximal bulkhead having a mass which is greater than the mass of said distal bulkhead." Our discussion concerning the patentability of the appealed claims will focus on these limitations.

We do not find an express disclosure in any of the applied references of a club head in which the distal portion has a smaller mass than the proximal portion. Nevertheless, the examiner considers that it would have been obvious to so construct the club head disclosed by Simmons. As the examiner argues on pages 13 and 14 of the answer (emphasis added):

Simmons clearly states that weights [40, 41] are positioned in the distal and proximal bulkheads and the weights may vary depending on the requirements

of the user of the head (Col. 3, Lns. 59-61). Clearly with the amount of golfers there are many types of swing errors which golfers need to correct for. Some golfers have a tendency to allow the face of a putter head to open when impacting a ball which causes errors in a putt. To correct this, these golfers add additional weight to the toe portion of a head to give a toe more momentum and thus the face will be less likely to open when impacting a ball. Other golfers have a tendency to allow a face of a putter head to close when impacting a ball which causes errors in a putt. To correct this, these golfers add additional weight to the heel of a head to give a heel more momentum and thus the face will be less likely to close when impacting a ball. It is considered reasonable to take the position that there will be golfers using the head of Simmons which [sic: who] will tend to close the face due to their putting swing and strength when impacting a ball. These golfer's [sic] will require weighting the heel portion heavier than the toe portion to correct this error. The references [sic] of Mendenhall was used to show that another method of varying the weight of a head is not by having weight inserts but buy [sic: by] changing the shape of cavities. Finney was used to show that size and material can also be used to vary weight positioned behind a face of a head. But with respect the [sic: to] this argument these references were not really needed and Simmons alone provides the motivation to obtain the weight positioning as that as [sic] claimed which is to meet the requirements of a user in particular who tends to close the face when putting (See paragraph 2 in (10)).

Column 3, lines 59 to 61 of Simmons, to which the examiner refers, reads as follows:

The weight of the solid weights 40 and 41 and the metallic material for the solid weights 40 and 41

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may vary depending on the requirements of the user  
of the club head 10.

It is not clear to us that this disclosure of Simmons would have suggested to one of ordinary skill that weight 40 may have a different mass than weight 41; but even if it would have done so, we find no motivation in Simmons, Mendenhall or Finney for making the mass of the distal weight 41 less than the mass of the proximal weight 40.

It is well settled that a rejection must be supported by evidence of an asserted suggestion, teaching or motivation. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). The fact that the prior art could be modified to produce the claimed structure would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Laskowski, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989). In the present case, the examiner's statement, underlined above, to the effect that golfers who allow the face of the putter head to close add weight to the heel of the head, is not supported by any evidence, as appellant argues on page 3 of the reply brief. If anything, the position of the weight 30 in the

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Simmons club head is such that the mass of the distal toe portion would be greater than the proximal heel portion, and there is no disclosure in any of the applied references which would teach or suggest the opposite arrangement to one of ordinary skill in the art.

Accordingly, rejections (1) to (5) will not be sustained.

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Conclusion

The examiner's decision to reject claims 1 to 3 and 5 to 21 is reversed.

REVERSED

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|-----------------------------|---|-----------------|
| IAN A. CALVERT              | ) |                 |
| Administrative Patent Judge | ) |                 |
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|                             | ) |                 |
|                             | ) | BOARD OF PATENT |
| CHARLES E. FRANKFORT        | ) | APPEALS AND     |
| Administrative Patent Judge | ) | INTERFERENCES   |
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|                             | ) |                 |
| JEFFREY V. NASE             | ) |                 |
| Administrative Patent Judge | ) |                 |

IAC/dal



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